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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,582	10/18/2001	John H. Niland	125536-1001	7597

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EXAMINER

SOOHOO, TONY GLEN

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/982,582

Applicant(s)

NILAND, JOHN H.

Examiner

Tony G Soohoo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

**Claims 11 and 12, presented in the request for RCE on 6/2/03 are now pending.**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hines et al. 6042259 (previously cited) in view of Rinzler 5507109 and in further view of Cowan 5918924.

Note:

MPEP 2144.04, I. states with regards to aesthetic changes .

#### 2144.04 Legal Precedent as Source of Supporting Rationale

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

#### I. AESTHETIC DESIGN CHANGES

In re Seid , 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art

Applicant desires to patentably prevent the public and others to have an article of a cement truck, or to paint a concrete mixer truck with a rotating mixer drum. In particular a cement truck whereby the drum is painted with a sign, such as a company

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name or logo, which is painted on a diagonal from the drum rotation axis and on both sides of the drum. Inherently due to the a diagonal orientation of the indicia, the sign extends helically around the mixer drum circumference. Furthermore, the sing on both sides of the drum is in an inverted position from one another. Thereby both signs are readable in their entirety from the opposite sides of the drum during the rotation.

The following finding of facts has been found by the examiner and has been established as prior art known to the public.

1) A sign or indicia upon a cement mixer rotating drum is an old and well known article, and it is an old and well known technique to paint a sign on a cement mixer drum so that it may be identified. Evidence is shown by the indicia 15 upon the rotating drum 15 of the cement mixer truck 12 of the Hines et al 6042259 (Hines '259) reference (previously cited) for the reasons of identification of the vehicle, column 6, lines 13-17.

2) The provision of a signage on a vehicle upon both sides of a truck surface has been found to be an old and well known technique and use upon an article for a person having ordinary skill in the art for the purposes of advertising. Whereby an advertising signage is placed on both sides (i.e. opposing sides) of the vehicle for advertising on both sides of the truck to increase advertising surface.

Evidence is shown by the depiction of the signage upon figure 1 of the reference to Rinzler 5507109 which teaches respective advertising indicia, e.g. "SIGNAGE 1" and "SIGNAGE 2" for the provision on the sides of a vehicle whereby the indicia is placed on one side and the other side is disposed in an opposite circumferential position of the

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vehicle body with the indicia is inverted with respect to the other so as to be readable from both sides of the vehicle when viewed circumferentially.

3) The provision of advertising text or images which are placed at diagonal angles, or skew from the horizontal upon plural surfaces of a vehicle sides, is old and well known in the art of the graphic arts and advertising. Use of signage upon plural sides and the non traditional orientation of such indicia inherently provides variety and dynamism to the indicia upon the vehicle.

Evidence of such a common use and article that is known to the public is shown by the Cowan 5918924 reference in figure 1. Cowan teaches a vehicle 12 which has at least two sides (i.e. the driver side "STOP CHILD ABUSE" and the rear side "DRINK COLA" ) with respective indicia whereby at least a part of the indicia is disposed upon a diagonal- non traditional orientation. In particular the words "STOP" and "C O L A" are placed on a diagonal, or offset manner.

A review of the finding of facts follows:

It has been determined by the Examiner that the Hines et al '259 reference discloses all of the recited subject matter as defined within the scope of the claims with the exception of 1) the provision and method of providing signage extending in a helical patten with respect to the rotation of the drum axis and 2) the placement of signs on both sides of the mixer surface so that both sides may read the signage from opposite sides of the drum.

Findings in light of the prior art is as follows:

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It is noted that the test for obviousness under 35 USC 103 is what the combined teachings of the applied references, when taken as a whole, would have suggested to one of ordinary skill in the art. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore motivation for combining references need not be explicitly found in references themselves, and examiner may provide explanation based on logic and sound scientific reasoning that will support a holding of obviousness. Ex parte Levengood, 28 USPQ2d 1300 (BPAI 1993).

With regards to the 2<sup>nd</sup> issue, In light of the evidence as shown by Rinzler 5507109 that it has been known and in common knowledge to use on indicia on both opposite circumferential sides of a vehicle body, with the indicia is inverted with respect to the other so as to be readable from both sides of the vehicle, it is deemed that it would have been obvious to one of ordinary skill in the art to one may provide indicia on both sides of the mixer drum of a cement mixer truck such as a type shown by Hines et al '259 and located in an opposite circumferential position of the vehicle body so the indicia is inverted with respect to the other so as to be readable from both sides of the vehicle in order to easily identify the truck. It is further noted that the provision of a second indicia on the other side would also involve a duplication of parts to put the same sign upon the other side of the truck. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

With regards to the 1<sup>st</sup> issue, in light of the evidence that technique

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to provide for a vehicle, signage which is placed at angles, offsets, and diagonals from the horizontal in order to provide aesthetic value of variety, and/or dynamism, such as evidenced by figure 1 of Cowan 5918942, it is deemed that it additionally would have been obvious to one of ordinary skill in the art to further modify the indicia placement of both signage upon both sides of the cement drum so that it is in a diagonal, or offset from the axis of rotation thereby providing an appropriate aesthetic value of variety, and/or dynamism. Additionally, such a modification would involve a rearrangement of parts of the text itself, it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

#### Response to Arguments

3. Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The McCall 460537 reference establishes an example from 1891 that a technique of the placement of signage which is placed on both sides of a vehicle whereby when viewed in a circumferential manner (from the side of the vehicle, to the top of the vehicle, And over to the other side of the vehicle), the words or placed in inverted manner to one another. Weaver 3453759 teaches inverted placement of the same text so that it may be seen from both sides at one.

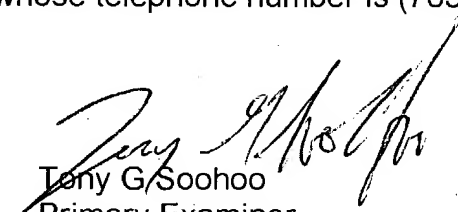
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The Vogel 369305 and House et al 2002061, and Weaver 3453759 references establishes respective examples from 1887 and 1935 and 1969 of a technique of providing indicia or advertisement which is placed at an angle or diagonal upon the surface of the device and additionally shows a technique of placing plural signage upon circumferentially of a body whereby the advertising may be viewed at circumferentially offset or opposite positions around the body.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony G Soohoo whose telephone number is (571) 272 1147. The examiner can normally be reached on 7:00 AM - 5:00 PM, Tues. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tony G Soohoo  
Primary Examiner  
Art Unit 1723

tgs